

REMARKS

Claims 1, 2, 4-12, and 15-20 are all the claims pending in the application.

Applicant herein amends independent claims 1 and 17 for clarity. No new matter has been added.

Claims 1-4 and 4-8 stand rejected 35 U.S.C. § 103(a) as being unpatentable over Toy et al. (U.S. 6,192,115; hereinafter "Toy") in view of Koster (U.S. 6,259,914) further in view of Kung et al. (6,373,817; hereinafter "Kung"). Applicant respectfully traverses this rejection.

Independent claim 1 now recites, in part:

a mode changing unit that changes a mode of a connection between said caller terminal and said mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from said caller terminal[.]

Thus, independent claim 1 requires, *inter alia*, a mode changing unit that changes a mode of a connection between a caller terminal and a mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from the caller terminal.

The Examiner admits that neither Toy nor Koster teach or suggest this unique feature. Nonetheless, the Examiner contends that Kung discloses these features, and points to col. 10, lines 57-63 in support of his position. The cited portion states:

The announcement server 220 may have information entered by a user using, for example, a broadband residential gateway 140 to provide additional information to the called party. The additional information may include the ability to leave a message, type in a chat note, page the called party, barge in on the call, and/or other user or system defined call handling capabilities.

Thus, Kung discloses that the announcement server (220) may provide additional information to the called party, including the ability to leave a message, type in a chat note, page the called party, barge in on the call, and/or other user or system defined call handling capabilities. That is, the announcement server (220) in Kung only provides information to the called party. In other words, the announcement server (220) in Kung merely provides information; it does not change the mode of the connection, as independent claim 1 requires.

Moreover, as pointed out above, independent claim 1 requires that the mode changing unit change a mode of a connection between a caller terminal and a mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from the caller terminal. By contrast, Kung only discloses that the “additional information” provided to the called party may be a “message” or a “chat note.” Applicant submits that providing a “message” or a “chat note” as additional information does not correspond to changing a conversation mode to a text-based mail sending mode, as claim 1 requires.

Thus, Applicant submits that Kung fails to teach or suggest the features missing from Toy and Koster. Consequently, Applicant submits that none of the applied references, either alone or in combination, teach or suggest all of the features required by independent claim 1.

Further, independent claim 1 further requires:

wherein if said mode changing unit that changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to send a text-based mail message to said mobile station[.]

Thus, independent claim 1 further requires that the notification system allow the caller terminal to send a text-based mail message to the mobile station.

Even assuming, *arguendo*, that Kung discloses changing from a conversation mode to a message sending mode, a “message” and a “chat note” do not necessarily correspond to text-based mail, as independent claim 1 requires. A “message” could include, for example, a voicemail message. Similarly, a “chat note” could include, for example, a message sent as part of a two-way chat session. Indeed, Kung is completely silent on any mention of a “text based mail message.” As such, Applicant submits that Kung fails to teach or suggest this unique feature of the claimed invention.

Furthermore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to send text based messages instead of talking to the called party if parties are not simultaneously available. Applicant respectfully disagrees with the Examiner’s position.

Applicant respectfully submits that whether a motivation to combine prior art references has been demonstrated is a question of fact.¹ In making such a determination the law requires some teaching, suggestion or reason coming from the prior art itself; otherwise, the conclusion to be reached is that the motivation is predicated on hindsight.² Teachings in the prior art that teach

¹ See *Wimmer Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 53 USPQ2d 1580, 1586 (Fed. Cir. 2000).

² See *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F. 3d 1573, 1579, 42 USP2d 1378, 1383 (Fed. Cir. 1997).

away from combination of the references must also be considered.³ In the present Office Action, the Examiner has failed to cite any objective evidence found within the references themselves that provide a motivation to combine the three references. The Examiner has simply recited unfounded motivations for combining discrete elements from each reference.

Applicant therefore submits that the Examiner's analysis is nothing more than a classic hindsight reconstruction where the claimed invention is debased and trivialized because in retrospect, the Examiner can find the elements existing individually in a number of prior art references. Such a hindsight construction has been condemned by the Federal Circuit. The Examiner must examine the claimed invention as a whole for obviousness, not simply the discrete elements, as it appears the Examiner has done here.

Judge Clevenger speaking for the Federal Circuit on the issue in *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) stated,

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion, or reason" to combine cited references.

As noted above, the Examiner has not provided any particularized factual findings in either of the applied references to support his position. As such, Applicant submits that the Examiner has failed to make a *prima facie* case of obviousness.

³ See MPEP 2141.02(VT).

Accordingly, Applicant submits that independent claim 1 is patentable over the applied references, at least for the reasons stated above. Further, Applicant submits that dependent claims 2-4 and 4-8 are patentable over the cited references, at least by virtue of their dependency on independent claim 1.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toy in view of Koster, in further view of Kung and in further view of Dunn. Applicant respectfully traverses this rejection.

Dunn fails to cure the deficiency noted above regarding Toy, Koster and Kung. Thus, none of the applied references, either alone or in combination, teach or suggest all of the claimed features. Therefore, Applicant submits that dependent claims 9 and 10 are also patentable over the cited references, at least by virtue of their dependency on independent claim 1.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toy in view of Koster, in further view of Kung and in further view of Asano et al. (hereinafter "Asano"). Applicant respectfully traverses this rejection.

Asano fails to cure the deficiency noted above regarding Toy, Koster and Kung. Thus, none of the applied references, either alone or in combination, teach or suggest all of the claimed features. Therefore, Applicant submits that dependent claims 11 and 12 are patentable over the cited references, at least by virtue of their dependency on independent claim 1.

Claims 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koster in view of Frey et al. (hereinafter "Frey"), in further view of Kung. Applicant respectfully traverses this rejection.

Frey fails to cure the deficiency of the applied references noted above regarding independent claim 1. Thus, none of the applied references, either alone or in combination, teach or suggest all of the claimed features. Therefore, Applicant submits that independent claim 17 is patentable over the applied references for reasons analogous to those stated above regarding independent claim 1. Similarly, Applicant submits that dependent claims 18-20 are patentable over the applied references, at least by virtue of their dependency on independent claim 17.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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